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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/460,292	12/10/1999	David J. Mangelsdorf	UTSD:596	2313

7590

06/13/2002

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EXAMINER

WOITACH, JOSEPH T

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 06/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**Application No.  
**09/460,292**Applicant(s)  
**Mangelsdorf, D. et al.**Examiner  
**Joseph T. Weitach**Art Unit  
**1632**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Apr 29, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Jan 24, 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached.

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1, 2, 4-14, 23-27, 29, 44, and 45

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

10. ☐ Other: \_\_\_\_\_

*Deborah Crouch*

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Section 2(a):

Claim amendments to claims 1, 2, 21, 26, 44 and 45 encompass an allele that 'can not express LXR $\alpha$  sufficient to provide' from one that lacks the capacity to respond alters the scope of the claims, raising new issues under 35 USC 112, first and second paragraphs, regarding what is encompassed by 'sufficient' levels and how one would achieve said levels. Claim amendments to claims 4 and 5 to recite 'a transcript produced from said LXR $\alpha$  allele' increases the breadth of the claim from only a disruption in the allele to means of generating altered transcripts either by a disruption in the gene or by other mechanisms which result in an altered transcript, such as specifically altering splice sequences, introducing frame shifts, or introducing large heterologous sequences to disrupt the transcript. In each case the proposed amendments require further consideration and search of the relevant art regarding the new issues the proposed amendments raise.

Section 5(a):

The petition to correct inventorship and supporting declarations mailed January 24 ,2002, papers numbers 17-19 and mailed February 15, 2002, paper number 21, has been received and entered. The consent of the assignee, the declaration of Drs. Mangeldorf, Turley and Dietschy, and the supplemental declaration of Daniel J. Peet and Jean-Marc A. Lobarccaro are found to be sufficient.. However, a new oath or declaration in compliance with 37 CFR 1.63 identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.



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Specifically, the oath or declaration is defective because it was not executed in accordance with either 37 CFR 1.66 or 1.68.

Because the inventorship of the instant application has been amended, the rejection made under 35 USC 102(a) is maintained for the reasons of record. It is noted that amending the inventorship would obviate the basis of the rejection because the art would no longer be by another.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist Pauline Farrier whose telephone number is (703)305-3550.

Joseph T. Woitach